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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,866	09/12/2000	Scott J. Jones	GOLDENH.001C1	2541

20995 7590 07/05/2006

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ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 07/05/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/659,866
Filing Date: September 12, 2000
Appellant(s): JONES ET AL.

John M. Carson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 18 April 2006 appealing from the Office action
mailed 15 June 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. However, Examiner notes that in the Summary of Claimed Subject Matter Appellant makes frequent reference to cancelled Claim 1. Examiner assumes that Appellant meant, in these instances, to refer to independent Claim 2.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1. Aeromed website. 02-1998

URL: <[http:// www.aeromed-software.com](http://www.aeromed-software.com)>

2. 5, 122, 959A Nathanson et al. 06-1992

3. Schriewer, Scott article. 05-1996

"Airborne Ambulance Saves Precious Time," Tulsa World.

4. Hudson, Terese article. 04-1991

"Attorneys Fear Patient Transfer Claims in Malpractice Cases,"
Hospitals; Chicago, volume 65, issue 7.

5. 5,974,355A Matsumoto et al. 10-1999

6. 6,044,323A Yee et al. 03-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 2 and 9 are rejected under 35 U.S.C. 102(a).

Claims 2-29 are rejected under 35 U.S.C. 103(a).

These rejections are set forth in prior Office Action, Paper No 05272005 and reproduced hereinbelow. The rejections which appear below substantially repeat the rejections made in the previous Office Action (Paper No 05272005). The text of those sections of Title 35 U.S. Code relied upon in the Examiner's Answer is set forth in the previous Office action, Paper 05272005.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 2 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Aeromed (“www.aeromed-software.com,” February 5, 1998).

(A) As per claims 2 and 9, Aeromed teaches a computerized system for managing airborne transportation of a patient comprising:

a first module comprising instructions for dispatching an aircraft carrying an airborne emergency transport crew to a patient site (Aeromed; pages 4 and 5);

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a second module comprising instructions for generating a calculated flight path to the patient site (Aeromed; pages 4 and 5); and

a third module comprising instructions for tracking the actual flight path of the vehicle and determining whether the actual flight path varies from the calculated flight path and for tracking flight coordinates of the aircraft (Aeromed; pages 4 and 5).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-5, 10, 15, and 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nathanson et al. (5,122,959) in view of Schriewer (Schriewer, Scott, "Airborne Ambulance Saves Precious Time," Tulsa World, May 22, 1996, pages 1-2).

(A) As per claim 2, Nathanson teaches a computerized system for managing transportation of a patient comprising:

a first module comprising instructions for dispatching a vehicle carrying an emergency transport crew to a patient site (Nathanson; Abstract, column 4, lines 21-27, column 16, line 42-column 18, line 5, and column 21, lines 6-31);

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a second module comprising instructions for generating a calculated path to the patient site (Nathanson; column 18, lines 8-28); and

a third module comprising instructions for tracking the actual path of the vehicle and determining whether the actual path varies from the calculated path (Nathanson; column 19, line 43 to column 20, line 2).

Nathanson fails to expressly teach the vehicle being an aircraft carrying an emergency transport crew to a patient site.

However, this feature is old and well known in the art, as evidenced by Schriewer's teachings with regards to a computerized system for managing airborne transportation for an aircraft carrying airborne emergency transport crew to a patient site (Schriewer; page 1, paragraph 1).

It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Nathanson with Schriewer's teaching with regards to these limitations, with the motivation of "transporting critical-care patients or accident victims ... [where] ... time is of the essence" (Schriewer; page 1, paragraph 1, lines 5-6).

(B) As per claims 3-5, Nathanson fails to expressly teach wherein the vehicle is a helicopter, the patient site is an accident site, and the patient site is a hospital. However, this feature is old and well known in the art, as evidenced by Schriewer's teachings with regards to wherein the vehicle is a helicopter, the patient site is an accident site, and the patient site is a hospital (Schriewer; page 1, paragraph 1). It is respectfully submitted, that it would have been

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obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Nathanson with Schriewer's teaching with regards to these limitations, with the motivation of "transporting critical-care patients or accident victims ... [where] ... time is of the essence" (Schriewer; page 1, paragraph 1, lines 5-6).

(C) Claim 10 repeats the features of claim 2 and is therefore rejected for the same reasons given above in the rejection of claim 2 and incorporated herein.

(D) Method claim 15 repeats the subject matter of system claim 2, as a series of steps rather than a set of apparatus elements. As the underlying structure of claim 2 has been shown to be fully disclosed by the teachings of Nathanson and Schriewer in the above rejection of claim 2, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, these limitations are rejected for the same reasons given above for system claim 2, and incorporated herein.

(E) As per claims 20-25, Nathanson and Schriewer teach a system and method as analyzed and discussed in claims 2 and 15 above

wherein the determining whether the actual flight path varies from the calculated flight path includes identifying a variation from the calculated flight path (Nathanson; column 30, lines 10-21);

wherein the third module additionally comprises instructions for making information regarding the variation available to at least a fourth module (Nathanson; column 30, lines 10-21);

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wherein the information regarding the variation comprises a reason for the variation (Nathanson; column 30, lines 10-21);

wherein the fourth module comprises instructions for calculating a bill at least in part based on the information regarding the variation (Nathanson; column 7, lines 24-27);

additionally comprising storing a reason for a variation between the actual flight path and the calculated flight path (Nathanson; column 30, lines 10-21); and

additionally comprising calculating a bill at least in part based on the variation (Nathanson; column 7, lines 24-27).

(F) As per claims 26-28, Nathanson and Schriewer teach a system and method as analyzed and discussed in claim 2 above

wherein the instructions for tracking comprise instructions for automatically monitoring (reads on tracking) (Nathanson; column 4, lines 21-27), and wherein the actual flight path of the aircraft is stored data (reads on recorded) (Nathanson; column 4, lines 31-35);

wherein the instructions for tracking comprise instructions for recording the actual flight path of the aircraft (Nathanson; column 4, lines 21-35); and

wherein the instructions for determining comprise instructions for calculating a deviation from the actual flight path (Nathanson; column 18, lines 8-27, column 19, lines 19-67, column 30, lines 10-21).

5. Claims 6-7, 11-12, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nathanson et al. (5,122,959) and Schriewer (Schriewer, Scott, "Airborne Ambulance Saves Precious Time," Tulsa World, May 22, 1996, pages 1-2) as applied to claims 5, 10, and 15

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above, and further in view of Hudson (Hudson, Terese, "Attorneys Fear Patient Transfer Claims in Malpractice Cases," Hospitals; Chicago; April 5, 1991, volume 65, issue 7, pages 44-48).

(A) As per claims 6-7, the combined system of Nathanson and Schriewer collectively fail to expressly teach wherein the first module comprises instructions for determining whether transportation of the patient from the patient site to another hospital is in compliance with interfacility transportation guidelines, wherein the guidelines are the Consolidated Reconciliation Act or the Omnibus Budget Reconciliation Act. However, this feature is old and well known in the art, as evidenced by Hudson's teachings with regards to determining whether transportation of the patient from the patient site to another hospital is in compliance with interfacility transportation guidelines, wherein the guidelines are the Consolidated Reconciliation Act or the Omnibus Budget Reconciliation Act (Hudson; abstract, page 1, last paragraph). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Nathanson and Schriewer with Hudson's teaching with regards to these limitations, with the motivation of avoiding malpractice suits (Hudson; Abstract).

(B) Claim 11-12 repeat the features of claims 6-7 and are therefore rejected for the same reasons given above in the rejection of claims 6-7 and incorporated herein.

(C) Method claims 16-17 repeat the subject matter of system claims 6-7, as a series of steps rather than a set of apparatus elements. As the underlying structure of claims 6-7 has been shown to be fully disclosed by the teachings of Nathanson, Schriewer, and Hudson in the above

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rejection of claims 6-7, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, these limitations are rejected for the same reasons given above for system claims 6-7, and incorporated herein.

6. Claims 8, 13, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nathanson et al. (5,122,959) and Schriewer (Schriewer, Scott, "Airborne Ambulance Saves Precious Time," Tulsa World, May 22, 1996, pages 1-2) as applied to claims 2, 10, and 15 above and further in view of Matsumoto et al. (5,974,355).

(A) As per claim 8, the combined system of Nathanson and Schriewer collectively fail to expressly teach wherein the first module comprises instructions for storing crew work schedules for the emergency transport crew. However, this feature is old and well known in the art, as evidenced by Matsumoto's teachings with regards to storing crew work schedules for the emergency transport crew (Matsumoto; Abstract and column 12, lines 31-50). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Nathanson and Schriewer with Matsumoto's teaching with regards to these limitations, with the motivation of facilitating an effective crew flight scheduling pattern (Matsumoto; Abstract).

(B) Claim 13 repeats the features of claim 8 and is therefore rejected for the same reasons given above in the rejection of claim 8 and incorporated herein.

(C) Method claim 18 repeats the subject matter of system claim 8, as a series of steps rather than a set of apparatus elements. As the underlying structure of claim 8 has been shown to

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be fully disclosed by the teachings of Nathanson, Schriewer, and Matsumoto in the above rejection of claim 8, it is readily apparent that the system disclosed by Nathanson, Schriewer, and Matsumoto include the steps to perform these functions. As such, these limitations are rejected for the same reasons given above for system claim 8, and incorporated herein.

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7. Claims 9, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nathanson et al. (5,122,959) and Schriewer (Schriewer, Scott, "Airborne Ambulance Saves Precious Time," Tulsa World, May 22, 1996, pages 1-2) as applied to claims 2, 10, and 15 above, and further in view of Yee et al. (6,044,323).

(A) As per claim 9, the combined system of Nathanson and Schriewer collectively fails to expressly teach wherein the third module comprises instructions for tracking the flight coordinates of the aircraft. However, this feature is old and well known in the art, as evidenced by Yee's teachings with regards to instructions for tracking the flight coordinates of the aircraft (Yee; Abstract, column 7, lines 42-50). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Nathanson and Schriewer with Yee's teaching with regards to these limitations, with the motivation of determining positional information of the aircraft and providing a "single integrated system which provides global coverage of all of the communication, navigation and surveillance functions required by an [air traffic control] ATC system" (Yee; Abstract, column 2, lines 17-20).

(B) Claim 14 repeats the features of claim 9 and is therefore rejected for the same reasons given above in the rejection of claim 9 and incorporated herein.

(C) Method claim 19 repeats the subject matter of system claim 9, as a series of steps rather than a set of apparatus elements. As the underlying structure of claim 9 has been shown to be fully disclosed by the teachings of Nathanson, Schriewer, and Yee in the above rejection of claim 9, it is readily apparent that the system disclosed by the applied prior art include the steps to perform these functions. As such, these limitations are rejected for the same reasons given above for system claim 9, and incorporated herein.

8. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schriewer (Schriewer, Scott, "Airborne Ambulance Saves Precious Time," Tulsa World, May 22, 1996, pages 1-2) in view of Nathanson et al. (5,122,959).

(A) As per claim 29, Schriewer teaches a computerized system for managing airborne transportation of a patient comprising

a first module comprising instructions for dispatching an aircraft carrying an airborne emergency transport crew to a patient site (Schriewer; page 1, paragraph 1).

Schriewer fails to explicitly disclose

a second module comprising instructions for generating a calculated flight path to the patient site; and

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a third module comprising instructions for recording the actual flight path of the aircraft and calculating a variation from the actual flight path.

However, the above features are well-known in the art, as evidenced by Nathanson.

In particular, Nathanson teaches

a second module comprising instructions for generating a calculated flight path to the patient site (Nathanson; column 18, lines 8-28); and

a third module comprising instructions for recording the actual flight path of the aircraft and calculating a variation from the actual flight path (Nathanson; column 19, line 43 to column 20, line 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Schriever to include a second module comprising instructions for generating a calculated flight path to the patient site and a third module comprising instructions for recording the actual flight path of the aircraft and calculating a variation from the actual flight path., as taught by Nathanson, with the motivations of providing an integrated vehicle dispatch system that performs the management, coordination and communications functions for dispatching vehicles, providing a pricing program, such that all the prices can be automatically generated for each transaction, and providing the user of the program with a snapshot of key operational statistics for a given period of time (Nathanson; column 2, lines 50-53, column 3, lines 41-48).

(10) Response to Argument

In the Appeal Brief filed 18 April 2006, Appellant makes the following arguments:

- (A) Claim 2 is Not Anticipated by Aeromed Because the Declaration Under 37 C.F.R. 131 to Overcome Aeromed Presents Sufficient Facts to Establish Either Reduction to Practice or Conception Coupled with Due Diligence Prior to the Effective Date of the Aeromed Reference
- (B) Claim 2 is Not Anticipated by Aeromed Because Aeromed Fails to Disclose Instructions For Determining Whether The Actual Flight Path Varies From the Calculated Flight Path and Because Aeromed Does Not Contain Enabling Disclosure of Instructins For Dispatching An Aircraft
- (C) Claims 2, 10 and 15 Are Not Obvious Over The Nathanson Reference In View of the Schriewer Reference, At Least Because Both Nathanson and Schriewer Fail to Teach or Suggest Instructions for Determining Whether the Actual Flight Path Varies From The Calculated Flight Path

Examiner will address Appellant's arguments in sequence as they appear in the brief.

- (A) Claim 2 is Not Anticipated by Aeromed Because the Declaration Under 37 C.F.R. 131 to Overcome Aeromed Presents Sufficient Facts to Establish Either Reduction to Practice or Conception Coupled with Due Diligence Prior to the Effective Date of the Aeromed Reference

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In response to Appellant's treatment of chronological issues of record in Appellant's application, Examiner respectfully thanks Appellant for this description, provided from page 8 to page 10, paragraph 2 of the Appeal brief filed 18 April 2006. However Examiner is unable to observe, in the paragraph described by Appellant in footnote 22, the incorrect reference to the Nathanson reference in the 2003 action, as noted by Appellant. Further, Examiner notes an apparent typographical error in line 2, page 10 of the Appeal brief, where Appellant asserts that Examiner stated the filing date of the application to be "12 September 2002."

In response to Appellant's assertion, on page 10, paragraph 3 to page 11, bottom, of the Appeal brief, that, the Affidavit filed 20 December 2004 to remove Aeromed (<http://www.aeromed-software.com>) as a reference applied under 35 U.S.C. § 102(a) in the previous Office Actions "is sufficient to show that the invention was reduced to practice prior to February 5, 1998, or that in the alternative, if the Declaration is insufficient to establish actual reduction to practice, the facts illustrate due diligence coupled with prior invention," Examiner respectfully disagrees.

As regards its contents, the affidavit includes sections of a copy of a manuscript describing the capabilities of the system (Exhibit Sheets A1, A2, and A3), with portions of A1 and A3 redacted, three figures from the same manuscript (Exhibit Sheets B1, B2, and B3), a copy of a section of a document, entitled "Vision" (Exhibit Sheet C), a portion of which has been redacted, a copy of a section of a document, entitled "Operational Uses" (Exhibit Sheet D), a portion of which has been redacted, and drafts of figures used in prior patent applications (Exhibit Sheets E1, E2, and E3), portion of which have been redacted. At page 1, paragraph 4.a.

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of the affidavit, the Applicant states that the subject matter set forth in claims 2 and 9 was conceived of no later than February 5, 1998. Further, at page 5, paragraph 5, of the affidavit, the Applicant states that the elements of claims 2 and 9 “were clearly conceived prior to February 5, 1998, and either actually reduced to practice or was undergoing due diligence to reduce to practice prior to February 5, 1998,” (emphasis added).

According to MPEP § 715.04, in general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. In the instant case, it is respectfully submitted that it is unclear what invention was reduced to practice no later than February 5, 1998, in light of the fact that Exhibit D includes predictive language such as “...we could possibly reduce fuel expense ...” (paragraph 4) and “[o]ther potential uses” (paragraph 1). As stated above, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. The Exhibit sheets fail to show that the apparatus actually existed and worked for its intended purpose. It appears, according to the Exhibit sheets that the invention had been conceived on paper at an undisclosed date, and that the Applicant appears to have determined what the functions of the product *would be* in the future. However, it is not clear from the Exhibit sheets what was reduced to practice no later than February 5, 1998.

As such, Examiner interprets Applicant’s reliance on the affidavit filed 20 December 2004, including Exhibit Sheets A1, A2, and A3, B1, B2, and B3, C, D, E1, E2, and E3, to show actual reduction to practice to be non-persuasive for the reasons given above. Therefore, constructive reduction to practice is the filing date of the application, 12 September 2000, and reduction to practice has not been shown to be earlier than 12 September 2000.

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Further, even if the invention was conceived prior to February 5, 1998, the Applicant would need to show due diligence from the date of conception to the date of filing, 12 September 2000. An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.). (MPEP 2138.06). Examiner respectfully notes that none of the Exhibit sheets are dated.

Moreover, Examiner respectfully notes that Applicant's statement at page 5, paragraph 5, of the affidavit filed 20 December 2004 stating that the elements of claims 2 and 9 "were clearly conceived prior to February 5, 1998, and either actually reduced to practice or was undergoing due diligence to reduce to practice prior to February 5, 1998," (emphasis added) makes it unclear as to which of these two conditions apply, and unclear as to what was actually reduced to practice and what was undergoing due diligence.

However, if the Applicant properly shows actual reduction to practice occurred no later than February 5, 1998 based on MPEP § 715.02, MPEP § 715.04, and the discussion above, the requirement to show due diligence will be removed.

With regard to Appellant's arguments in paragraph 2 of page 11 regarding "a state complete enough to be considered a beta testing stage" and "complete enough to be presented at the Air Medical Transport Conference in Cincinnati prior to February 5, 1998," Examiner finds these arguments, when interpreted together with the Exhibits referred to in these arguments, (Appellant's affidavit filed 20 December 2004), to be non-persuasive to show that the apparatus actually existed and worked for its intended purpose prior to February 5, 1998.

With regard to Appellant's footnote number 34, on page 11 of the Appeal brief, Examiner respectfully notes that there is no Office Action dated June 15, 2004, however Examiner interprets this footnote to contain a typographical error, referring instead to the Office Action dated June 15, 2005; Examiner additionally notes that the Office Action of June 15, 2005 contains no paragraph 13 on page 13. As such, Examiner interprets this footnote to refer to paragraph 2 on page 13 of the Office Action mailed June 15, 2005.

With regard to Appellant's arguments in paragraph 3 of page 11 that the period of time during which due diligence must be shown is from February 5, 1998 until the filing date of the parent application, Examiner agrees, and thanks Appellant for providing this information. However, as discussed above, Examiner has cited court cases that have determined that an

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applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts) (emphasis added) (MPEP 2138.06). As such, Examiner finds Appellant's arguments, when interpreted together with the Exhibits referred to in these arguments, (Appellant's affidavit filed 20 December 2004), to be non-persuasive to show that "the creation of the beta test version prior to the constructive reduction to practice on March 2, 1998 is sufficient to establish due diligence" during this period of time.

With regard to Appellant's discussion of the "Supplemental Declaration," filed 13 April 2006, in paragraphs 1-2 of page 12 of the Appeal Brief, Examiner notes that this document has not been entered into the record for the following reasons:

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37 CFR 41.33 (d) states: An affidavit or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made. In the present case, Appellant fails to provide good and sufficient reasons why the affidavit is necessary and why it was not earlier presented. All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). As such, the “Supplemental Declaration,” filed 13 April 2006 will not be further discussed in this Examiner’s Answer.

(B) Claim 2 is Not Anticipated by Aeromed Because Aeromed Fails to Disclose Instructions For Determining Whether The Actual Flight Path Varies From the Calculated Flight Path and Because Aeromed Does Not Contain Enabling Disclosure of Instructins For Dispatching An Aircraft

With regard to Appellant's assertion in the paragraph bridging pages 12-13 of the Appeal brief that “the Examiner failed to establish a *prima facie* case of anticipation of claims 2-9,” Examiner notes that claims 3-8 were rejected under 35 U.S.C. 103(a). As such, Examiner interprets this statement to be an apparent typographical error, which should have read “a *prima facie* case of anticipation of claims 2 and 9).

With regard to Appellant's assertion in the paragraph bridging pages 12-13 of the Appeal brief that the applied reference fails to teach or suggest the limitations of claim 2, Examiner respectfully disagrees with Appellant's interpretation of the Aeromed reference. Applicant argues that Aeromed does not disclose or suggest a computerized system comprising "a third module comprising instructions for tracking the actual flight path of the vehicle and determine whether the actual flight path varies from the calculated flight path." However, the Examiner understands the Aeromed reference to teach a system which produces flight plans and also to teach features that calculate navigation for the entire flight plan and display nearest aircraft to the scene (in order to determine the nearest aircraft to the scene the system in Aeromed must determine the actual location of the aircraft), and thus determines the deviation from the calculated flight plan. Furthermore, Examiner interprets the Aeromed reference as providing instructions to the user for determining whether the actual flight path varies from the calculated flight path, i.e. "Aeromap shows you the flight plans of all active units as lines on the map. Position reports are shown as dots. Watch your aircraft as it flies to its destination! You can easily tell if it is off-course [reads on "instructions for determining whether the actual flight path varies from the calculated flight path"]," (emphasis added) (Aeromed; page 9, last paragraph).

Furthermore, with regard to Appellant's assertions, from the last complete paragraph on page 13 through paragraph 2 on page 14, that Aeromed does not disclose or suggest a computerized system, Examiner interprets Aeromed's teachings on page 10, paragraph 1, i.e. "Tired of following your units by hand? AeroMap connects directly to the Newcomb satellite transceiver to get position reports and unit status automatically" (emphasis added) as teaching using a computerized system.

Furthermore, Examiner notes that claim 2 is directed to instructions for tracking and instructions for determining, and not to actually tracking and determining. Examiner respectfully notes that instructions for preparing Eggplant Parmesan does not guarantee a cooked dinner.

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Accordingly Examiner disagrees with Appellant's contention to the contrary and asserts that a *prima facie* case of anticipation has indeed been established.

With regard to Appellant's arguments from paragraph 3 on page 14 to paragraph 3 on page 15 of the Appeal brief that the Aeromed reference is not enabling, it has been held that lack of diagrams, flow charts, and other details in the prior art references did not render them non-enabling in view of the fact that applicant's own specification failed to provide such detailed information, and that one skilled in the art would have known how to implement the features of the references (*In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994); and also that the claims represented by applicant must distinguish from the alleged inoperative reference disclosure. *In re Crosby*, 157 F.2d 198, 71 USPQ 73 (CCPA 1946).

As per Appellant's discussion regarding claim 2 at pages 15-16 of the Appeal brief and of Appellant's references to "the cited portion" of the Aeromed reference, Examiner notes that Appellant appears to rely upon only a small subset of Examiner's applied art. Further it is the entire applied reference, and not only the cited passages that must be considered when evaluating whether or not the applied reference teaches the cited limitations.

As per Appellant's reference to cancelled Claim 1 on page 15, Examiner assumes that this was another typographical error and that Appellant meant to refer to independent Claim 2.

With regard to Appellant's arguments on page 15-16 of the Appeal brief that the Aeromed reference does not disclose "how to dispatch an aircraft" Examiner respectfully notes this is not a claimed limitation, however Examiner also notes that Aeromed does teach "an integrated real-time dispatching program used to log incoming requests, find coordinates or landmarks, such as hospitals... [...] ... produce flight plans and dispatch the aircraft" (reads on the claimed limitation: "instructions for dispatching an aircraft") (Aeromed, page 4, paragraph 1). As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, it is respectfully submitted that Applicant appears to view the applied without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

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With respect to Appellant's argument at paragraphs 1-2, on page 17 of the Appeal Brief response that the Aeromed reference does not teach a "how to dispatch an aircraft" and is not enabling, these arguments have been previously discussed in this Examiner's Answer.

(C) Claims 2, 10 and 15 Are Not Obvious Over The Nathanson Reference In View of the Schriewer Reference, At Least Because Both Nathanson and Schriewer Fail to Teach or Suggest Instructions for Determining Whether the Actual Flight Path Varies From The Calculated Flight Path

With respect to Appellant's argument on pages 17-21 of the Appeal Brief that the limitations of Applicant's invention are not taught or suggested by the applied references and that a *prima facie* case of obviousness has not been established. Examiner respectfully disagrees.

In response to Appellant's treatment of chronological issues of record in Appellant's application, Examiner respectfully thanks Appellant for this description, provided from page 17 to page 19, line 16 of the Appeal brief filed 18 April 2006.

With regard to Applicant's arguments in the last paragraph on page 19 of the Appeal Brief that "the cited portion of Nathanson which discusses the on-board vehicle hardware does not itself teach instructions ..." Examiner notes that Applicant appears to rely upon only a small subset of Examiner's applied art. Further it is the entire combined applied reference(s), and not only the cited passages that must be considered when evaluating whether or not the applied references teach the cited limitations.

In response to Appellant's argument in the last paragraph on page 19 of the Appeal Brief that "the cited portion of Nathanson which discusses the on-board vehicle hardware does not itself teach instructions ...", Examiner notes that Nathanson teaches "an automated vehicle locator system" that "automatically updat[es] the actual position of the vehicles on the graphic display monitor ... [...] ... displayed in the form of coordinate maps" and "[t]he software of the delivery system is organized into three main programs supported by numerous subroutines and functions" and "the dispatcher ... [...] ... program ... [...] ... assigns routes to selected vehicles, calculates the minimum path travel times for those routes and monitors the successful completion of pick-ups and deliveries," (Nathanson; column 4, lines 1-27). Furthermore, Nathanson teaches "the vehicle itinerary file is updated and time stamps are placed on the transaction showing estimated time of pickup and estimated time of deliveries" and "[t]he third check mark represents a confirmation of arrival at the destination point and is represented by the letter "D" when confirmed" (Nathanson; column 19, lines 35-65). Examiner interprets these teachings of software (reads on "instructions") that monitors travel times and actual positions of vehicles traveling on assigned routes to teach, "instructions for tracking the actual ... [...] ... path of the vehicle and determining whether the actual ... [...] ... path varies from the "assigned" (reads on "calculated") ... [...] ... path."

Furthermore, as noted earlier in this Examiner's Answer, Examiner notes that claim 2 is directed to instructions for tracking and instructions for determining, and not to actually tracking and determining.

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With regard to Appellant's arguments in paragraph 1 on page 20 of the Appeal Brief that the Nathanson transportation dispatch and tracking system is visible only to the driver, Examiner respectfully disagrees, and notes that Nathanson's "system consists of specialized software combined with a micro-computer network and graphics terminals where vehicle operators, dispatchers and customers are able to efficiently schedule deliveries" (Nathanson; column 2, lines 53-57) and in which "[t]he network is fully redundant such that each input in one micro-computer is stored in the memories of all microcomputers in the system. Each of the dispatcher workstations include[s] microcomputers which control text and color graphics monitors. A mobile digital data device is connected both to the dispatch workstations and to a radio transceiver. The mobile device supplies information to a transceiver on board the vehicles. That information is then processed by vehicle-based microcomputers," (Nathanson; column 3, lines 58-67). Examiner interprets these teachings as displaying the information to many participants in the dispatch and tracking system.

With regard to Appellant's statement in paragraph 1 on page 20 of the Appeal Brief that

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there is no "motivation to modify the system to include such instructions," Examiner notes that Nathanson's system includes these recited instructions, as has been previously discussed in this Examiner's Answer, and that therefore no such modification has been put forth.

With respect to Appellant's argument at page 20, paragraph 2 to page 21, paragraph 3 of the Appeal Brief response that the Nathanson reference does not teach "instructions for ... determining whether the actual flight path varies from the calculated flight path", these arguments have been previously discussed in this Examiner's Answer.

In addition, as regards Appellant's assertion in the paragraph bridging pages 21-11 that "the Examiner has failed to make out a *prima facie* case that claim 2 is obvious over Nathanson in view of Schriewer," the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. Note, for example, the motivations explicitly stated at the last paragraph of page 4 of the previous Office Action (paper number 05272005) (i.e., " ... with the motivations of transporting critical-care patients or accident victims ... [where] ... time is of the essence"; and at lines 2-3 of page 9 of the previous

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Office Action (i.e., " ... with the motivations of facilitating an effective crew flight scheduling pattern ").

Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 05272005)

As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, it is respectfully submitted that Applicant appears to view the applied references separately, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Conclusion

Appellant's arguments at pages 8-22 of the Appeal brief submitted 18 April 2006 do not appear to persuasively require a withdrawal of the Examiner's grounds of rejection. As specified in the remarks and rebuttals given above, Appellant's arguments apparently fail to appreciate the clear and unmistakable suggestions provided in the prior art of record, and relied upon by the

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Examiner for motivation to combine such well-known elements of the prior art. As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of anticipation and obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Examiner's Answer as well as the previous Office Action (paper number 05272005), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).


Thus, in light of the reasons and responses given above, it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Art Unit 3626


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